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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/705,195

11/10/2003

Volker Buttcher

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EXAMINER

PAGE, BRENT T

ART UNIT

PAPER NUMBER

1638

NOTIFICATION DATE

DELIVERY MODE

01/28/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/705,195 | Applicant(s) BUTTCHEER ET AL. | |
| | Examiner BRENT PAGE | Art Unit 1638 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 6-9, 15 and 16 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23, 32, 34, 36, 46, 48 and 50 is/are allowed.
- 6) ☒ Claim(s) 1-5, 10-14, 17-22, 24-30, 47-44, and 51-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Reply filed by Applicant on 10/23/2008 is hereby acknowledged. The addition of New Claim 55 is hereby acknowledged. Claims 1-55 are pending. Claims 6-9 and 15-16 remain withdrawn as being drawn to nonelected subject matter. Claims 1-5, 10-14 and 17-55 are examined herein on the merits. Any objection or rejection of record not specifically addressed below is considered to be hereby withdrawn in response to Applicants arguments when taken together with the claim amendments.

Double Patenting

Claims 1-5, 10-14, 17-22, 24-30, 37-44 and 51-54 remain and claim 55 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-4, 6, 8, 11, 13, 15 and 17 of U.S. Patent No.6566585. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the limitations of the current claims are met by the claims and narrow genus of patent 6566585. The claims are rejected for the reasons of record in the office actions mailed out 10/10/2007 and 07/23/2008 as well as the reasons set forth below.

Applicant's arguments filed 10/23/2008 have been fully considered but they are not persuasive.

Applicants urge that US patent 6566585 is not the same invention and is not identical subject matter under 35 USC 101 (page 12 of response).

This is not persuasive because the claims are rejected under obvious-type double patenting and not statutory double patenting.

Applicants urge that a time extension would not be given if the patent issues.

This is not persuasive because patent law prevents the issue of more than one patent for the same invention.

Applicants urge that the disclosure may not be used as prior art and that only the claims may be used in determining double patenting (pages 13-14).

This is not persuasive because the MPEP states in MPEP 804 (II) (B) (1) states "Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). The court in *Vogel* recognized 'that it is most difficult, if not meaningless, to try and say what is or is not an obvious variation of a claim,' but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent which provides support for the patent claim". It is recognized that the disclosure may not be relied on for what is not claimed, but wherein an embodiment of the claim is present in the disclosure that directly supports a claim, it may be relied upon for a double patenting determination. The MPEP further states "this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 USC 103, since only the

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disclosure of the invention claimed in the patent may be examined". In this particular case SEQ ID NO:1, which is 100% identical to SEQ ID NO:1 of the instant claims is the only embodiment supporting the claim of the branching enzyme in US Patent 6566585, and as such is anticipatory to the sequence of the instant claims.

In response to Applicant's arguments that a foreign nucleic acid molecule comprising a branching enzyme and a foreign nucleic acid molecule comprising a branching enzyme and an amylosucrase protein are not obvious variants of one another, one has to determine if the instant claims are anticipated by the patent claims. Because the instant claims do not exclude other proteins and are generic to the claims of the patent, the claims of US patent 6566585 do anticipate the instant claims and meet all of the claim limitations, thus necessitating the rejection of obvious-type double patenting.

Applicants further urge on pages 14-15 that only the claims of the patent may be used in the analysis and that the claim includes all branching enzymes and therefore is not a narrow genus.

This is not persuasive because as discussed above, the direct support for a claim may be used in determining obvious variants. The sequence of the instant claims is present in the only working example of US patent 6566585, thus the sole means of support for the claims where structure and function are demonstrated is present in SEQ ID NO:1, which is a narrow genus.

Claims 23, 32, 34, 36, 46, 48, and 50 are allowable.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRENT PAGE whose telephone number is (571)272-5914. The examiner can normally be reached on Monday-Friday 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571)-272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brent T Page
/Russell Kallis/
Primary Examiner, Art Unit 1638